

REMARKS

Claims 1, 4-6 and 8-15 are pending in this application. Claims 14 and 15 stand allowed. By this Amendment, claim 7 is canceled without prejudice to or disclaimer of the subject matter recited therein. Claim 1 is amended to incorporate the subject matter of canceled claim 7. Thus, no new matter is added.

I. Information Disclosure Statement

An Information Disclosure Statement was filed on March 3, 2004 concurrently with this application. In the Amendment filed on November 23, 2004, Applicants requested acknowledgement of receipt and consideration of the references listed therein. As Applicants have not received the requested acknowledgment of receipt and consideration, Applicants again respectfully request that the Form PTO-1449, included with the Information Disclosure Statement filed on March 3, 2004, be initialed and returned to Applicants.

II. Allowed Claims

The allowance of claims 14 and 15 is appreciated. Applicants submit that the remaining pending claims are in condition for allowance for the reasons discussed below.

III. Claim Objections

Claim 13 is objected to under 37 C.F.R. §1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. It is alleged in the Office Action that the subject matter of claim 13 is recited in independent claim 1. Although claim 1 currently recites that "the terminal holder provides longitudinal walls protruding in the axial direction on both sides of the slot, the longitudinal walls restricting the plate-like terminal from moving in its thickness direction," claim 1 does not disclose the additional features recited in claim 13. For example, claim 1 does not recite that the terminal holder provides a wall portion protruding in the axial direction along the terminal for restricting the terminal

from moving in a thickness direction of the terminal. Thus, withdrawal of the objection to claim 13 is respectfully requested.

IV. Claim Rejections Under 35 U.S.C. §103

Claims 1, 4, 6, 8, 12 and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,423,117 to Okada et al. (Okada) in view of U.S. Patent No. 5,548,260 to Kogure et al. (Kogure). The rejection is respectfully traversed.

Neither Okada or Kogure, whether considered alone or in combination, disclose or suggest each and every feature recited in the rejected claims. For example, the combination of references fails to disclose or suggest an electromagnetic switch for a starter, comprising: a bobbin; a plate-like terminal having a first end and a second end, the first end being attached to the bobbin in an axial direction of the bobbin; an excitation coil wound around the bobbin, an end of the excitation coil being pulled out the bobbin and connected to the terminal; and a cover mounted on the terminal, wherein the terminal passes through the cover in the axial direction, wherein: the bobbin has a first flange and a second flange, the first flange has a terminal holder that protrudes from the first flange in the axial direction and defines a slot on an axial end surface to receive the first end of the terminal, and the terminal holder provides longitudinal walls protruding in the axial direction on both sides of the slot, the longitudinal walls restricting the plate-like terminal from moving in its thickness direction, wherein the first end of the terminal has a serrated portion, as recited in amended claim 1.

It is alleged in the Office Action that Okada discloses a bobbin having a first flange 10b and a second flange 10c, and the first flange has a terminal holder 22 that protrudes from the first flange in the axial direction and defines a slot on an axial end surface to receive the first end of the terminal. However, Okada discloses no such slot. Rather, Okada merely discloses the terminal holder 22 having an anchor hole in which the rod-like coil terminals 11

are inserted (see Fig. 2, col. 3, lines 38-42). Such an anchor hole 22 does not provide longitudinal walls protruding in the axial direction on both sides of the slot because a hole formed to receive a rod-like coil terminal is also circular in shape and therefore cannot provide longitudinal walls protruding in the axial direction on both sides of the slot, i.e., a circle does not have sides. Additionally, such a hole will not provide longitudinal walls on both sides of the slot that restrict the terminal from moving in its thickness direction.

It is admitted in the Office Action that Okada also fails to teach a plate-like terminal as recited in the rejected claims. To overcome the admitted deficiency, Kogure is combined with Okada for its alleged teaching of plate-like terminals. Specifically, the Office Action alleges that Kogure discloses plate-like terminals 25 enclosed by a cover 21. Although Fig. 2 shows a switch terminal 25, the only description of the feature is of the switch terminal 25 "extending through the wall of the switch cover 21" (col. 4, lines 17 and 18). Thus, there is no description of a "plate-like terminal" in Kogure. Furthermore, as shown in Fig. 2, the switch terminal 25 is not attached to the bobbin. Rather, the terminal 25 appears to be attached to another member which is inserted into the bobbin 15. Additionally, Kogure, like Okada, fails to disclose or suggest a terminal holder that provides longitudinal walls protruding in the axial direction on both sides of the slot, the longitudinal walls restricting the plate-like terminal from moving in its axial direction. Rather, Kogure merely discloses what appears to be an additional member that is unlabeled in the figure inserted into the bobbin 15. Accordingly, withdrawal of the rejection of claims 1, 4, 6, 8, 12 and 13 is respectfully requested.

Claims 5, 7 and 9-11 are rejected under 35 U.S.C. §103(a) as unpatentable over Okada in view of U.S. Patent No. 6,628,187 to Hashimoto et al. (Hashimoto). As claim 7 is canceled the rejection of that claim is moot. The rejection of claims 5 and 9-11 is traversed.

Although claim 7 is canceled, the subject matter of claim 7 is incorporated into independent claim 1. Therefore, the subject matter of claim 7 will be discussed in reference to the specific rejection of the subject matter of that claim as being unpatentable over Okada in view of Hashimoto.

In rejecting claim 7, it is alleged in the Office Action that Okada "in view of Hashimoto et al. discloses the claimed invention except for the first end of the terminal having a serrated portion." It is alleged that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a serrated portion at the end of the terminal that contact the bobbin in order to facilitate its attachment to the bobbin by increasing the surface for the use of adhesive to bond the terminal and the bobbin.

In rejecting claims under 35 U.S.C. §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. *In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In doing so, the Examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

As neither of the cited references disclose the serrated portion as recited in the claims, the Office Action has failed to provide a *prima facie* case for obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claim combination and the reasonable expectation of success must be found in the prior art and not based on Applicants' disclosure (see MPEP 706.02(j)). The Examiner fails to show support in either of the references for such a claimed

serrated portion. Furthermore, the Office Action admits that neither of the references discloses or suggests such a serrated portion, but merely makes the conclusory statement that it would have been obvious for one of ordinary skill in the art to do so without providing any support for the conclusory statement. Finally, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

As the Office Action has failed to set forth a *prima facie* case of obviousness, withdrawal of the rejection of the subject matter of claim 7, as recited in amended claim 1, is respectfully requested.

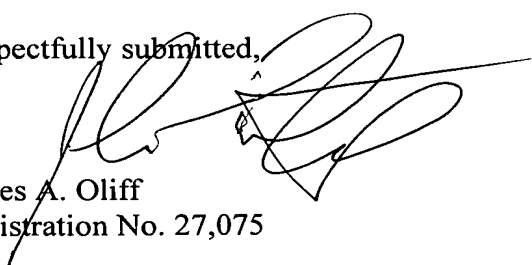
Additionally, claims 5 and 9-11 are allowable at least for the dependency on independent claim 1 for the reasons discussed above, as well as for the additional features recited therein. Thus, withdrawal of the rejection of claims 5 and 9-11 is respectfully requested.

V. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 4-6 and 8-15 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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